

REMARKS

This paper is filed in response to the office action mailed on February 11, 2005. Claims 1 and 3 have been amended; claims 10-16 have been added; claims 1-16 are pending.

In the office action, claims 1-4 and 6-9 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of four different references; U.S. Patent No. 5,594,806 ("Colbert"); U.S. Patent No. 6,142,876 ("Cumbers"); U.S. Patent No. 6,460,848 ("Soltys"); and U.S. Patent No. 5,386,103 ("DeBan").

In response, amendments have been made to claim 1 and applicants respectfully submit that the obviousness rejection does not meet the standards of MPEP §§ 2142 and 2143 for the following reasons. Specifically, under MPEP §§ 2142 and 2143,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

*Citing, In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *see also* MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

Applicants respectfully submit that the obviousness rejection of claims 1-4 and 6-9 is improper for it fails to establish a *prima facie* case of obviousness for at least two reasons. First, the proposed hypothetical combination does not teach or suggest all the claim limitations of amended claim 1 and there is no motivation or suggestion either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the references, without using applicants' disclosure as a template. In short, applicants respectfully submit that the Patent Office is using impermissible hindsight. *In re Rouffet*, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

Amended claim 1 now requires the simultaneous gathering of images associated with the person using the card at the exterior of the machine as well as the interior of the gaming machine along with the comparing of the stored first facial image information

and the current facial image information to confirm the person using the card is the party to whom the card was issued. Thus, claim 1 requires the gathering of image information relating to the interior of the machine, the exterior of the machine and the person using the card of the machine. No combination of the prior art references teaches or suggests this combination.

The base reference, Colbert, is not directed toward gaming machines at all but instead is directed toward a security system that uses a knuckle profile. Thus, Colbert is clearly deficient as a base reference as it really has no applicability to gaming machines or facial image information.

In an attempt to supplement Colbert, the Patent Office relies upon Cumbers. Cumbers does teach the use of facial images for security purposes but teaches nothing about the monitoring of activities associated with the exterior and the interior of the gaming machine in addition to capturing a facial image of the player using a card at the machine. Thus, neither Colbert nor Cumbers teaches or suggests the combination of video surveillance of an interior and exterior of a machine as well as the person using the card at the machine.

In an attempt to supplement Colbert and Cumbers, the Patent Office then relies upon Soltys. Soltys is directed toward methods for monitoring casinos and gaming in general. However, Soltys does not teach or suggest the simultaneous video surveillance of the interior and exterior of a machine along with capturing the facial images of a player using the card at the machine. Instead, Soltys is merely directed toward the use of exterior cameras only.

Finally, the Patent Office relies on DeBan. DeBan is not directed toward gaming or gaming machines. DeBan is directed toward automatic teller machines. While DeBan discloses the use of magnetic cards at an ATM and the transmission of facial image information to a remote location where a comparison is made to an image on file, DeBan in no way teaches or suggests the video surveillance of an interior and exterior of any machine, whether it be a ATM or a gaming machine.

Therefore, no combination of these four references teaches or suggests all of the limitations of amended claim 1 and therefore no *prima facie* case of obviousness has been established. Further, applicants respectfully submit that the use of four disparate references, two of which have nothing to do with gaming or gaming machines, would render any

reformulated obviousness rejection to be based on impermissible hindsight in violation of the provisions of the MPEP and the relevant case law.

Finally, the Patent Office rejects claim 5 under 35 U.S.C. § 103 as being unpatentable over Colbert, Cumbers, Soltys, DeBan and further in view of U.S. Patent No. 5,801,766 ("Alden").

However, Alden merely teaches the transformation of an analog signal to a digital signal, is not directed toward gaming machines or security at gaming machines and therefore is not cited for the proposition that it discloses any of the missing limitations described above. That is, Alden does not teach or suggest the simultaneous monitoring of the interior, exterior and the person using the card as recited in amended claim 1. Therefore, no combination of Alden and the other four references teaches or suggests the method of amended claim 1 and therefore the obviousness rejection of claim 5 is improper and should be withdrawn.

With all prior art references having been traversed, Applicants respectfully submit that this application is in a condition for allowance and an early action so indicating is respectfully requested.

The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855.

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Respectfully submitted,

By 

Michael R. Hull

Registration No.: 35,902  
MARSHALL, GERSTEIN & BORUN LLP  
233 S. Wacker Drive, Suite 6300  
Sears Tower  
Chicago, Illinois 60606-6357  
(312) 474-6300  
Attorney for Applicant